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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,110	03/28/2001	Ramanathan Ramanathan	42390P10983	2329

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EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/820,110	RAMANATHAN, RAMANATHAN
	<b>Examiner</b>	<b>Art Unit</b>
	Christian La Forgia	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 November 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 8/28/04 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 November 2004 has been entered.

2. Claims 1-27 have been presented for examination.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

4. See further rejections that follow.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-9, 11-14, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,629,150 to Huded, hereinafter Huded.

7. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

8. As per claims 1, 6, and 11, Huded teaches a method comprising:
  - writing a party's authenticating information and a first digital certificate issuing authority's authenticating information in an electronic document (Figure 3 [block 322]; column 3, lines 15-24);
    - signing, by the first digital certificate issuing authority, the electronic document to obtain a once signed electronic document (Figures 3 [block 321], 4 [block 321]; column 4, lines 7-45);
      - transmitting the once signed electronic document to a second digital certificate issuing authority (Figure 2; column 4, lines 46-59, column 6, lines 62-42, i.e. passing the once signed document from container 200 to container 150, transferring digital containers from Vendor A to Vendor B);
        - signing, by the second digital certificate issuing authority, the once signed electronic document to obtain a twice signed electronic document (Figures 5 [block 521], 6 [block 521]; column 4, lines 46-65); and
          - transmitting, by the second digital certificate issuing authority, the twice signed electronic document to the first digital certificate issuing authority and to the party (Figures 7, 8; column 4, lines 33-45, column 5, line 49 to column 6, line 7, i.e. transmitting to the original container and the client, or transmitting to the vendor who distribute to clients);

wherein the second digital certificate issuing authority is hierarchically superior to the first digital certificate issuing authority (column 6, lines 21-42, i.e. top level digital containers).

9. Regarding claims 2, 7, and 12, Huded discloses providing, as input to a hash algorithm, the contents of the electronic document (Figure 4 [blocks 230-232]; column 4, lines 7-17);

calculating, by the hash algorithm, a hash value (Figure 4 [blocks 311<sub>x</sub>, 400, 410]; column 4, lines 18-45);

encrypting the hash value using the first digital certificate issuing authority's private key (Figure 4 [blocks 420, 430]; column 4, lines 18-45); and

writing the encrypted hash value in the electronic document (Figure 4 [block 321]; column 4, lines 18-45).

10. Regarding claims 3, 8, 13, 17, 19, and 21, Huded discloses writing the second digital certificate issuing authority's authenticating information in the once signed electronic document (Figure 5 [block 522]; column 3, lines 15-24, column 4, lines 46-65);

providing, as input to a hash algorithm, the contents of the electronic document (Figure 6 [block 200]; column 4, lines 46-59);

calculating, by the hash algorithm, a hash value (Figure 6 [blocks 500, 510]; column 4, lines 46-59);

encrypting the hash value using the second digital certificate issuing authority's private key (Figure 6 ["Signatory Key" and "DSA"]; column 4, lines 46-59); and

writing the encrypted hash value in the electronic document (Figure 6 [block 521]; column 4, lines 46-59).

11. With regards to claims 4, 9, and 14, Huded discloses wherein calculating the hash value comprises providing as input to the hash algorithm at least one of the party's authenticating information, the first digital certificate issuing authority's authenticating information, the digital signature of the first digital certificate issuing authority, or the second digital certificate issuing authority's authenticating information (Figure 4 [blocks 311<sub>x</sub>, 400, 410]; column 4, lines 18-45).

12. As per claims 16, 18, and 20, Huded teaches a method comprising:  
receiving, from a first digital certificate issuing authority, a once signed electronic document at a second digital certificate issuing authority that is hierarchically superior to the first digital certificate issuing authority (Figure 2; column 4, lines 46-59, column 6, lines 21-42, column 6, lines 62-42, i.e. passing the once signed document from container 200 to container 150, transferring digital containers from Vendor A to Vendor B);  
writing the second digital certificate issuing authority's authenticating information in the once signed electronic document (Figures 5 [block 522]; column 3, lines 15-24, column 4, lines 46-65); and

signing, by the second digital certificate issuing authority, the once signed electronic document to form a twice signed electronic document (Figures 5 [block 521], 6 [block 521]; column 4, lines 46-65); and

transmitting, by the second digital certificate issuing authority, the twice signed electronic document to the first digital certificate issuing authority and to the party (Figures 7, 8; column 4, lines 33-45, column 5, line 49 to column 6, line 7, i.e. transmitting to the original container and the client, or transmitting to the vendor who distribute to clients).

***Claim Rejections - 35 USC § 103***

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 5, 10, 15, and 22-27 are rejected under 35 U.S.C. 103(a) as being obvious over Huded in view of U.S. Patent No. 6,301,658 to Koehler, hereinafter Koehler.

15. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

16. Regarding claims 5, 10, and 15, Huded teaches wherein writing a party's authenticating information and a first digital certificate issuing authority's authenticating information in an

electronic document comprises receiving the party's authenticating information (Figure 1 [block 155], column 3, lines 42-51).

17. Huded does not disclose wherein said transmission is made via a secure connection.
18. Koehler discloses wherein said transmission is made via a secure connection (column 2, lines 28-34).
19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the transmission via a secure connection, since Koehler states at column 2, lines 28-34 that such a modification would serve to validate the authenticity of a client.

20. Regarding claims 22-27, Huded does not teach wherein the second digital certificate issuing authority is a root digital certificate issuing authority.

21. Koehler discloses wherein the second digital certificate issuing authority is a root digital certificate issuing authority (column 3, lines 45-60).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the second digital certificate issuing authority as a root certificate issuing authority, since Koehler states at column 3, lines 45-60 that such a modification would establish authentication by verifying a hierarchical chain of digital signatures.

### ***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

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24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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